

United States District Court
Western District of Wisconsin
Joseph W. Skupniewitz

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WISCONSIN**

Filed/Received
10/18/2002 03:43:52 PM CDT

PROMEGA CORPORATION,

Plaintiff,

Case No. 01-C-0244-C

vs.

APPLERA CORPORATION; AND LIFECODES
CORPORATION, AND ITS SUBSIDIARIES
CELLMARK DIAGNOSTICS, INC. AND
GENOMICS INTERNATIONAL
CORPORATION,

Defendants.

DEFENDANTS' IDENTIFICATION OF PRIOR ART PURSUANT TO 35 U.S.C. § 282

Defendants hereby submit this identification of references pursuant to 35 U.S.C. § 282. Defendants reserve the right to supplement this statement as appropriate under the circumstances.

**I.
PATENTS AND PUBLICATIONS**

A. References Cited on the Face of the Patents-In-Suit (U.S. Patent Nos. 5,843,660 and 6,221,598)

Defendants identify the following references cited on the face of U.S. Patent Nos. 5,843,660 and 6,221,598 which they may rely on as anticipating U.S. Patent Nos. 5,843,660 or 6,221,598 or otherwise showing the state of the art:

- U.S. Patent No. 4,683,195, issued to Mullis et al., on 07/28/87 (APPL 037439-37473 and APPL 038809-38843)
- U.S. Patent No. 4,683,202, issued to Mullis, on 07/28/87 (APPL 037474-37501 and APPL 038844-38871)
- U.S. Patent No. 5,192,659, issued to Simons, on 03/09/93 (APPL 038872-38904)
- U.S. Patent No. 5,364,759, issued to Caskey et al., on 11/15/94 (APPL 037502-37534 and APPL 038905-38937)
- U.S. Patent No. 5,422,252, issued to Walker et al., on 06/06/95 (APPL 038938-38955)
- U.S. Patent No. 5,599,666, issued to Schumm et al., on 02/04/97 (APPL 038956-38983)
- U.S. Patent No. 5,843,660, issued to Schumm et al., on 12/01/98 (APPL 037535-37590)
- International PCT Publication No. WO 93/18177, issued to Fortina and Surrey, on 09/16/93 (APPL 037591-37628 and APPL 038984-39021)
- International PCT Publication No. WO 93/18178, issued to Fortina and Surrey, on 09/16/93 (APPL 037629-37661 and APPL 039022-39054)
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B. Other References

Defendants identify the following additional references which it may rely on as anticipating U.S. Patent Nos. 5,843,660 and 6,221,598 or otherwise showing the state of the art:

- U.S. Patent No. 6,221,598, issued to Schumm et al., on April 24, 2001.
- Ambach et al., "Multiplex-PCR: Application For Identification Of Fire-Victims," *Proceedings from the Sixth International Symposium On Human Identification* 1995, p. 158. (PM062849 and PM062685-62691)
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- Cooperative Human Linkage Center (“CHLC”) Database, including but not limited to accession numbers 40865, 31821, 40642, 40703, 31989, and 32029.
- GenBank Database

II.

PRIOR KNOWLEDGE, USE, OR SALE

Defendants identify each of the individuals listed as inventors and authors of the patents and publications listed above, see Section I supra, as persons who may be relied upon as the prior inventor or as having prior knowledge or as having previously used or offered for sale the invention of U.S. Patent Nos. 5,843,660 and 6,221,598, or as otherwise having knowledge of the state of the art. The last known address of these individuals is set forth in the patents and

publications listed above, see Section I supra, except that Defendants updates the address of, or otherwise identifies, the following individuals. Defendants herein incorporate by reference the disclosures of prior art to the '660 and '598 patents contained within the parties' expert reports and summary judgment briefs, as well as in the deposition testimony of the listed individuals.

Prior Invention

- Katherine Lazaruk, Applera Corporation, Applied Biosystems Division, 750 Lincoln Avenue, Foster City, California
- James Robertson, FBI, Quantico, Virginia
- Sean Walsh, Affymetrix, 3380 Central Expressway, Santa Clara, CA
- Martin Buonchristiani, California Department of Justice
- Jeanette Wallin, California Department of Justice

Prior Use Or Sale (Including Public Use And Sale Of Promega's CSF1PO And THO1 Monoplex Kits)

- James Schumm, 260 South Reynolds Street, Apartment 1509, Alexandria, Virginia
- Ann Lins, W12317 Whitetail Run, Lodi, Wisconsin
- Cynthia Sprecher, Promega Corporation, 2800 Woods Hollow Road, Madison, Wisconsin
- Kathy Micka, W3239 Schaefer Road, Belleville, Wisconsin
- Dawn Rabbach, Promega Corporation, 2800 Woods Hollow Road, Madison, Wisconsin
- Randy Dimond, Promega Corporation, 2800 Woods Hollow Road, Madison, Wisconsin
- Rhonda Rhoby, Applera Corporation, Applied Biosystems Division, 750 Lincoln

Avenue, Foster City, California

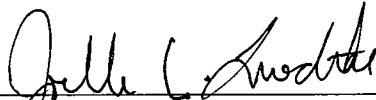
Sources Of Derivation Art

- Holly Hammond, 621 Melvins Road, Telford, PA
- Thomas Caskey, 711 Louisiana, Suite 3300, Houston TX
- Ron Fourney, Royal Canadian Mounted Police, Central Forensic Laboratory,
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Respectfully submitted,

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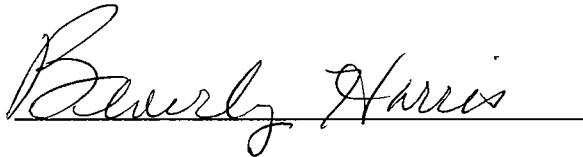
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CERTIFICATE OF SERVICE

I, Beverly Harris, do hereby certify that on this 18th day of October, 2002, a true and correct copy of Defendants' Identification Of Prior Art Pursuant To 35 U.S.C. § 282 was served, via Facsimile and Federal Express (Saturday Delivery), on the following addressees:

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A handwritten signature in cursive script, reading "Beverly Harris", is written over a horizontal line.